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JOSEPH C. KAWAN

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/238,995

**Applicant(s)**

KAWAN, JOSEPH C.

**Examiner**

Daniel S. Felten

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74 and 79-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74, 79-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt of the amendment filed March 01, 2007 is acknowledged. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74 and 97-81 are pending in the application and are presented to be examined upon their merits.

### ***Response to Arguments***

2. The applicant asserts that Gutman fails to teach or suggest a method of contact-less interfacing for a smart card, which a user is allowed to establish a physical contact bi-directional communication interface between a smart card and a hand-held device for accessing a smart card application on a microcomputer on the smart card. It is respectfully submitted to the applicant the references, in determining obviousness are not read in isolation but for what they fairly teach in combination with the prior art as a whole. In this case, it is maintained that the Gutman provides a system which allows the user to establish *physical* contact bi-directional communication between a financial card and a hand-held computing device for accessing a financial card application, whereby the financial card may be read or written into (see Gutman, column 5, line 44 to column 6, line 20). It has already been established in the previous Office Action that Gutman does not teach a smart card, however, However, it is maintained that reading and writing, can be considered a form of bi-directional communication in that the system responds and adapts to the card passively transmits and receives information provided to it. it is therefore maintained that Gutman's financial card provides the functional equivalent required in the limitation, that is, the physical contact and bi-directional communication between the financial card and the electronic wallet. Furthermore, it is also maintained that this limitation is

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not directly linked to contact-less interfacing for a smart card as set for in the applicant's preamble and thus the relative patentable weight of the limitation is uncertain.

Again, the applicant asserts, on page 10 of applicant's arguments, that Gutman does not teach or suggest a method of contact-less interfacing for a smart card in which the user is allowed to initiate a contact-less bi-directional communications interface via the hand-held computing device as a conduit between the smart card application on the microcomputer of the smart card and the self-service transaction terminal of the online system of the financial institution. It is respectfully submitted to the applicant, that merely dismissing Gutman's teaching as "nothing more than a wireless bi-directional communication directly between the hand-held device itself and a financial institution," shows that the applicant is providing a much narrower interpretation of the prior art than the claim language. This is an erroneous reversal of roles, where the Examiner must give the claims the broadest reasonable interpretation to the claims in light of the specification based upon what the prior art would suggest to one of ordinary skill in the art. That being the case, it seems obvious in reading Gutman, that one of ordinary skill in the art would recognize that the financial cards may be used *in concert with and not disjoined from* the wireless communication of the electronic wallet when dealing with financial transactions via the electronic wallet. It is maintained that since financial information can be provided by the card into the electronic wallet, and the electronic wallet encrypts and transmits via conventional techniques the financial information for security purposes (see column 8, lines 43+), the electronic wallet is being a conduit for the financial card in order to provide and receive information to and from the financial institution.

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In regards to the Dagger reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The applicant should also consider that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Dagger suggests that electronic purse systems have primarily adapted the smart card for retail payments (or financial transactions) and non-contact cards for transportation such as road tolls (see column 1, lines 57-67). As it was expressed in the previous office action, it would have therefore been obvious for one of ordinary skill in the art to modify/substitute a smart card for the magnetic card in Gutman in accordance to the teachings of Dagger to provided convenience to the user and to reduce the number of cards the user has to deal with. Again, the Dagger reference was provided to show that an artisan of ordinary skill in the art at the time of the invention would have sought to substitute the magnetic card of Gutman with a smart card to receive and transmit financial data or to provide the latest technology to the system. In order to clarify this position the Examiner further includes herein below another reference, Coutts (US 5,563,393) which shows a smart card (or PCMCIA card) used within a hand-held interface device, like Gutman, which bi-

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directionally communicates between the interface device and an ATM in a contact-less manner (see Coutts, Abstract, column 2, lines 43 +).

It is respectfully submitted that the submitted references teach the applicant's invention and provide the level of ordinary skill in the art.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74, 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Gutman et al (US 5,221, 838) in view of Dagger (US 5,748,737) and Coutts (US 5,563,393).

Gutman shows a method of contact less interfacing for a finance card which allows a user to establish a physical contact communication interface between a financial card (22) and a hand-held computing device (electronic wallet) for accessing a financial card application on the of the financial card (see col. 5, lines 44-65), *As in claims 1 and 63*

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--identify information and transaction information on the hand-held computing device (see col. 5, lines 57-59; and col. 7, lines 66 to col. 8, lines 2), *as in claims 1 and 63*

--initiate a contact less bi-directional communication interface via the hand-held computing device between the smart card application and a self-service transaction terminal of an on-line system of a financial institution (see fig. 1, col. 3, lines 46-68; and col. 4, lines 36-54), *as in claim 1 and 63*

--verify the financial card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device and the self-service transaction terminal (see col. 7, lines 66 to col. 8, line 2), *as in claims 1, 63 and 81 and*

--communicate the transaction information entered by the user on the hand-held computing device to the self-service transaction terminal of the on-line system via the contact less communication interface (see figs. 5B-5E, col. 12, line 64+; and col. 14, lines 17+), *as in claims 1, 63 and 81*

Gutman discloses that the financial card is a magnetic card that is used to exchange information, but fails to disclose that the financial card is a smart card. Dagger teaches that electronic purse systems have generally adopted the smart card for contact retail payments and non-contact cards for transportation payments such as tolls (see Dagger, col. 1, lines 57-67). Dagger also discloses Gutman failing to use the smart card (see col. 6, lines 36+). It would have been obvious for one of ordinary skill in the art to modify/substitute the smart card of Dagger for the magnetic card of Gutman to provide the latest electronic wallet technology to allow existing infrastructures to accept new digital card transactions, provide digital card storage, reduce

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fraud, etc., as enunciated in Dagger (see Dagger, col. 8, lines 3-43). Thus such modification would have been an obvious expedient to one of ordinary skill in the art.

Coutts discloses an interface device 12, that uses bi-directional communication between a PCMCIA card and a ATM via a interface device (see Coutts, Abstract, column 2, line 54 to column 3, line 23). It would have been obvious for an artisan of ordinary skill at the time to the invention to recognize that Gutman would have sought to modify it's invention with the PCMCIA card as provided in Coutts because an artisan would have desired the latest card technology to make secure financial transactions. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

*As in claims 2 and 64*, wherein the contact-less communication interface further comprises an infrared communication interface (see Gutman, col. 4, lines 36-54).

*As in claims 3 and 65*, wherein the contact less communication interface further comprises a wireless communication interface(see Gutman, col. 4, lines 36-54).

*As in claim 4 and 66*, further comprises a radio frequency communications interface(see Gutman, col. 4, lines 36-54).

*As in claim 5*, wherein the wireless communication interface(see Gutman, col. 4, lines 36-54)

*Re in claim 6*, wherein the radio frequency communication interface further comprises a proximity communication interface (see Gutman, col. 4, lines 35-55) .

*As in claim 8*, wherein the financial institution further comprises a bank (see Gutman, col. 7, lines 50-53).



*As in claim 9*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communications interface through a contact less communication transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claim 11*, wherein allowing the user to initiate the contact less communication interface between the smart card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through an ignored transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claims 12 and 69*, wherein the self-service transaction terminal further comprises an automated teller machine (see Dagger, col. 20, lines 11-19),

*As in claim 13 and 70*, wherein the self-service transaction terminal further comprises a personal computer (see Gutman, col. 9, lines 37-44).

*As in claims 14 and 71*, wherein the self-service transaction terminal further comprises a telephone (304) (see Gutman, fig. 4, col. 10, lines 66 to col. 11, line 50).

*As in claims 15*, wherein the self-service transaction terminal further comprises a wireless telephone (see "pager," col. 11, lines 9+).

*As in claim 16*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a wireless transceiver of the terminal (see "pager," col. 11, lines 9+).

*As in claim 17*, wherein the Wireless transceiver further comprises a radio frequency transceiver of the terminal (see col. 4, lines 36-54).

*As in claim 22*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a proximity transceiver of the terminal (see Gutman, col. 4, lines 35-55),

*As in claim 27*, wherein allowing the user to initiate the contact less communication further comprises allowing the user to initiate the contact less communication between the contact less communication transceiver of the self-service transaction terminal and a contact less communication transceiver of the hand-held computing device comprising a personal data assistant (electronic wallet) (see col. 9, lines 10-26).

*As in claim 33*, wherein the personal data assistant further comprises an electronic purse or wallet (see Abstract; also col. 3, lines 46+).

*As in claim 39*, wherein verifying the smart card further comprises verifying the smart card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device comprising a personal data assistant and the self-service transaction terminal(see col. 7, lines 66 to col. 8, line 2).

*As in claim 42*, wherein verifying the smart card further comprises verifying the authenticity of the financial card (see col. 7, lines 66 to col. 8, line 2).

*As in claim 43*, wherein verifying the financial card further comprises checking security information for the user.

*As in claim 44*, wherein checking security information further comprises receiving security information for the user (see col. 7, lines 66 to col. 8, line 2).

*As in claim 45*, wherein receiving security information further comprises receiving a PIN number (e.g. password) for the user (see col. 7, line 66 to col. 8, line 2).

*As in claim 47*, wherein receiving security information further comprises receiving the security information on an input/output device (see col. 7, lines 66 to col. 8, line 2)

*As in claim 48 and 73*, wherein receiving the security information further comprises receiving the security information through an input output device of the hand-held computing device comprising a personal data assistant (see col. 9, lines 10-26).

*As in claim 49 and 74*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

*As in claim 50*, wherein receiving the security information further comprises receiving the information through the input/output device of a terminal (see col. 7, line 66 to col. 8, line 2)

*As in claims 55*, wherein allowing the user to enter the transaction information further comprises receiving the information through an input/output device (see col. 7, line 66 to col. 8, line 2)

*As in claim 56*, wherein receiving the information further comprises receiving the information through the input/output device of the hand-held computing device comprising a personal data assistant (see col. 7, line 66 to col. 8, line 2)

*As in claim 57*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

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*As in claim 58*, wherein receiving the information further comprises receiving the information through the input output device of a terminal(see col. 7, line 66 to col. 8, line 2)

*As in claim 72*, The system of claim 63, wherein the on-line system comprises a bank host on-line system (see Gutman, col. 7, lines 50-53).

*As in claim 75*, wherein the accessing of the smart card application comprises executing the smart card application (see Dagger, col. 12, lines 1-8).

*As in claim 80*, wherein the accessing of the smart card application comprises loading the smart card application (see Gutman, col. 7, lines 50-53)

Re claim 46: computer systems receiving biometric information from a user (e.g., fingerprint, retina scan etc.) is notoriously old and well known for retrieving information that is uniquely and readily available from the user and is matched against the system's database to provide access similar to that of other well known techniques (e.g. PIN, password, etc.,). Thus Official Notice is taken of receiving biometric information because one of ordinary skill in the art would have recognized biometric data as an obvious alternative to the PIN and/or password disclosed in Gutman and Dagger to access their systems and to perform various transactions. Thus an artisan would have recognized the fact that to provide a fingerprint or a retina scan would substitute for a PIN number or password in the event that the PIN number and/or password was forgotten or lost. Thus the such a modification would be well within the ordinary skill of the art as well as being an obvious extension to the teachings of Gutman and Hsu to continue to allow users to access their systems without a PIN and/or password per se.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten  
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Art Unit 3693

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05/18/2007